

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86920414
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 113
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/86920414/large
<b>LITERAL ELEMENT</b>	CEO CONNECT
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
Please see the actual argument text attached within the Evidence section.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_999169106-20160802180157907691_ CEO_Connect_RequestforReconsideration_080216.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (3 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\869\204\86920414\xml9\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\869\204\86920414\xml9\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\869\204\86920414\xml9\RFR0004.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Request for Reconsideration document summarizing my response to Examining Attorney's Final Action including additional information in support of my argument for Likelihood of Confusion
<b>GOODS AND/OR SERVICES SECTION (current)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>DESCRIPTION</b>	
Providing an internet web site for business advertising to buy and sell; business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities	
<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 03/06/2014
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 03/06/2014
<b>GOODS AND/OR SERVICES SECTION (proposed)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Providing an internet web site for business advertising to buy and sell;</del> <a href="#">Promoting the goods and services of others by providing a web portal featuring company profiles for businesses to advertise products and services available for sale to be purchased by other businesses;</a> business-	

to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities	
<b>FINAL DESCRIPTION</b>	
Promoting the goods and services of others by providing a web portal featuring company profiles for businesses to advertise products and services available for sale to be purchased by other businesses; business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities	
<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 03/06/2014
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 03/06/2014
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>SUPPLEMENTAL REGISTER</b>	The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/staecy carpenter/
<b>SIGNATORY'S NAME</b>	Staecy Carpenter
<b>SIGNATORY'S POSITION</b>	Owner
<b>SIGNATORY'S PHONE NUMBER</b>	408-206-1074
<b>DATE SIGNED</b>	08/02/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Aug 02 18:28:53 EDT 2016
<b>TEAS STAMP</b>	USPTO/RFR-XX.X.XXX.XXX-20 160802182853893340-869204 14-55010a05a7b16e2612b3d3 f7a244ac78998908ea029f7dc 3855c21213c664cbfca9-N/A- N/A-20160802180157907691

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.  
PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86920414** CEO CONNECT(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86920414/large>) has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Please see the actual argument text attached within the Evidence section.

### EVIDENCE

Evidence in the nature of Request for Reconsideration document summarizing my response to Examining Attorney's Final Action including additional information in support of my argument for Likelihood of Confusion has been attached.

**Original PDF file:**

[evi\\_999169106-20160802180157907691\\_-\\_CEO\\_Connect\\_RequestforReconsideration\\_080216.pdf](#)

**Converted PDF file(s) ( 3 pages)**

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 035 for Providing an internet web site for business advertising to buy and sell; business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/06/2014 and first used in commerce at least as early as 03/06/2014 , and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** ~~Providing an internet web site for business advertising to buy and sell;~~ [Promoting the goods and services of others by providing a web portal featuring company profiles for businesses to advertise products and services available for sale to be purchased by other businesses;](#) business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities

Class 035 for Promoting the goods and services of others by providing a web portal featuring company profiles for businesses to advertise products and services available for sale to be purchased by other businesses; business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/06/2014 and first used in commerce at least as early as 03/06/2014 , and is now in use in such commerce.

**ADDITIONAL STATEMENTS**

**Supplemental Register**

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /staecy carpenter/ Date: 08/02/2016

Signatory's Name: Staecy Carpenter

Signatory's Position: Owner

Signatory's Phone Number: 408-206-1074

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either: (1) the owner/holder ; or (2) a person(s) with legal authority to bind the owner/holder; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86920414

Internet Transmission Date: Tue Aug 02 18:28:53 EDT 2016

TEAS Stamp: USPTO/RFR-XX.X.XXX.XXX-20160802182853893

340-86920414-55010a05a7b16e2612b3d3f7a24

4ac78998908ea029f7dc3855c21213c664cbfca9

-N/A-N/A-20160802180157907691



### **Request for Reconsideration**

- 1) Jennifer D. Richardson, Trademark Examining Attorney, Law Office 113
- 2) Serial No: **86920414**
- 3) Filing Date of Application: February 25, 2016
- 4) Date of this Action: August 2, 2016
- 5) Applicant Name, Address, Telephone and e-mail Address:  
Staacy L. Carpenter DBA ExeConnect  
POB 4777  
San Jose CA 95150  
(408) 206-1074  
staacy@execonnect.com
- 6) Word mark: **CEO CONNECT**

### **ISSUE:**

- Section 2(d) Refusal – Likelihood of Confusion

### **RESPONSE:**

Applicant's mark CEO CONNECT and Registrant's mark CEO CONNECTION have very different meanings and create substantially different commercial impressions. Because the purpose and use of the services are very different, and also the company names are different, it is very unlikely that relevant business consumers will believe there is any connection between the two companies: ExeConnect and CEO Connection. CEO CONNECT is an online service offered by company ExeConnect. ExeConnect has been in operation since 2002 (reference Principal Registration #s 4621323, 4241210, 3682249).

It may be helpful to have a better understanding of the purpose and function of CEO CONNECT. The traditional B2B sales process of telemarketing is slowly being replaced by new technologies and social media. Each time a telemarketer dials into a company in which they are looking to sell to (also referred to as "cold calling"), they have to 1) find out the name and title of the person who would "likely" have a need for a new product or service; 2) reach them via a "cold" introduction; 3) discover if there's a new product/service requirement or not; 4) if so, begin to sell them over the phone; 5) schedule a formal introduction. The first three steps of this process are the most time-consuming and can really have a negative impact on a company's sales productivity and the short window for going to market. The purpose of CEO CONNECT is to allow companies to immediately discover the right names/titles and the products/services in which profiled companies are looking to buy, and reach them via a "warm" introduction by requesting a meeting through the website. Just as companies outside CEO CONNECT can sell to companies profiled on CEO CONNECT, companies profiled also display information about their products/services in the event companies outside CEO CONNECT need to buy from them. People listed on company profiles span company-

wide (different departments and different titles), and they either have to have direct decision-making power (to buy/sell) or decision-making influence. Buying and selling products and services can be initiated with the first step of requesting a meeting via any of the Request Meeting buttons on each company profile. Introduction requests are then screened by ExeConnect. CEO CONNECT's service was put into place to accelerate the sales process, for start-up awareness, and to match vendors (big and small) together for business solutions. It came as a result of ExeConnect's many years of connecting companies for sales opportunities offline and wanting to leverage the Internet as businesses move more and more online.

Regarding the Registrant's CEO CONNECTION mark, "ION" creates a commercial impression different than the Applicant's CEO CONNECT mark. They also have different meanings in the dictionary. For example, the term "connect" can commonly refer to associate mentally or emotionally, while the term "connection" can commonly refer to anything that connects; a connecting part; link; bond; an electrical connection. I researched registered trademarks that have similar terms, that end in CONNECT and CONNECTION, with the first word identical in part. Below are a few I found:

- 1) EXPRESS CONNECT    Registration #: 4561003  
EXPRESS CONNECT    Registration #: 3493265  
EXPRESS CONNECTION    Registration #: 2294159
- 2) KIDS CONNECT    Registration #: 3084423  
KIDS CONNECTION    Registration #: 2808180
- 3) AIR>>CONNECT    Registration #: 4071920  
AIR CONNECTION    Registration #: 3023468

**ISSUE:**

- Section 2(e)(1) Refusal – Mark is Merely Descriptive

**RESPONSE:**

Requesting to amend to Supplemental register.

**ISSUE:**

- Requirement to Amend Identification of Services

**RESPONSE:**

I'm requesting to substitute with the following wording: ***"Promoting the goods and services of others by providing a web portal featuring company profiles for businesses"***

*to advertise products and services available for sale to be purchased by other businesses*; business-to-business services, namely, business meetings and introductions via online, in-person, telephone, video or electronic mail for business development; providing information relating to business projects and sales opportunities.”

Note: I removed the proposed “*Advertising services, namely,*” because I don’t consider CEO CONNECT as advertising services. Meeting or introduction services would be more appropriate; however I have that covered in the second line.